

REMARKS/ARGUMENTS

The Office Action mailed August 28, 2006, has been received and its contents carefully considered. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the foregoing amendments and the following remarks.

In the Office Action mailed August 28, 2006, claims 1-30 stand rejected. Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable.

Claims 1 and 17 are presently amended. No claims have been added. As such, claims 1-30 remain pending.

CLAIM REJECTION – 35 U.S.C. § 102(e)

Claims 1-3, 5, 12-14, 17, 19, and 26-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication 2003/0069589 to Small ("Small"). Specifically, the Office Action states that "Small discloses a clip with an integral cutting guide including a first leg (12) and second leg (11) joined by a flexible hinge (13), cutting guide (17) extending outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at least one of said first and second legs, and a female locking member (recess 19) and male locking member (hook 18), the male locking member is lockingly engaged in said female locking member so as to removably lock said first and second leg members of said surgical clip in said closed position."

To overcome the rejection, Applicant has amended Claims 1 and 17 to include limitations which more clearly represent what Applicant considers to be his invention. Applicant's

specification, at paragraph page 10, lines 27-28, recites that other structures cannot “function as cutting guides 80, since they do not have a length great enough to provide a stable platform for guiding the cutting implement.” One of ordinary skill in the art would have knowledge that a cutting guide needs to have a flat, smooth edge to allow cutting. Furthermore, as is apparent from viewing FIG. 3, the cutting guide (80) provides a flat, smooth cutting edge. As such, Claims 1 and 17, as amended, now include elements which are not disclosed in Small, specifically: a surgical clip with an integral cutting guide, including “a substantially flat exterior edge to provide a stable platform for guiding a cutting implement.” Small does not teach or disclose such a cutting guide.

By contrast, Small only contemplates an umbilical cord clamp having a “thumb wing”, which is composed of “outwardly facing surfaces to facilitate the secure gripping and manipulating of the clamp in use.” See paragraph 33, lines 1-2. This “thumb wing” surface is therefore meant to be gripped and pushed by user’s hand, and is not at all related to providing a cutting guide. Thus, the function and structure of the device in Small is quite different from that claimed in Applicant’s invention. Applicant’s invention, as claimed in amended Claims 1 and 17, discloses a cutting edge which must include a flat exterior edge or stable platform or cutting. This element is missing in Small. Thus, Claims 1 and 17 are not anticipated by Small.

Therefore, for the foregoing reasons, Applicant respectfully asserts that Claims 1 and 17, as amended, are patentable and are not anticipated by Small. and requests that the rejection with regard to Claims 1 and 17 be withdrawn.

Claims 2, 3, 5, 12-14, 19, and 26-28 depend directly or indirectly from one or another of independent Claims 1 and 17. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the

art of record. The dependent claims are therefore believed patentable. Applicant therefore respectfully requests that the rejection with regard to Claims 2, 3, 5, 12-14, 19, and 26-28 be withdrawn.

CLAIM REJECTION – 35 U.S.C. § 103(a)

Claims 1, 4, 6-11, 15-18, 20-25, and 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,062,846 to Oh, et al (“Oh”) in view of Small.

The prior art references once combined must teach or suggest all the limitations of the claimed combination. MPEP § 2143. Amended Claims 1 and 17 disclose a surgical clip with an integral cutting guide, including “at least one cutting guide extending outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at least one of said first and second legs... wherein each cutting guide includes a substantially flat exterior edge to provide a stable platform for guiding a cutting implement” (the foregoing underlined portions being currently added to the claim as an amendment). The Office Action admits, “Oh et al. does not teach cutting guides extending outward from and disposed along at least one of said first and second legs.” As discussed above, Small does not disclose a cutting edge as disclosed in Applicant’s invention. Thus, the combined references do not teach the disclosed inventions of claims 1 and 17. Applicant requests that the rejection with regard to claims 1 and 17 be withdrawn.

Dependent claims 4, 6-11, 15, 16, 18, 20-25, and 29-30 each depend, directly or indirectly, from one or another of independent claims 1, and 17. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since the independent claims are believed to be nonobvious and therefore patentable, their dependent claims are therefore believed to be patentable. Therefore, Applicant also respectfully requests that the rejection with regard to claims 4, 6-11, 15, 16, 18, 20-25, and 29-30 be withdrawn.

DOUBLE PATENTING

Claims 1-3, 6-13, 15-17, 20-27, 29 and 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of Wilson, Jr. (U.S. Patent No. 6,863,675) in view of Small. Applicant's disclosed cutting guide, having "a substantially flat exterior edge to provide a stable platform for guiding a cutting implement," is disclosed by neither Wilson nor Small. This limitation is not disclosed or suggested by the art of record. Therefore, Applicant respectfully requests that the rejection with regard to claims 1-3, 6-13, 15-17, 20-27, 29 and 30 be withdrawn.

Obviousness-type double patenting can in any case be avoided by filing a terminal disclaimer in the application. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Knohl*, 386 F.2d 476, 155 USPQ 586 (CCPA 1967). Without conceding the propriety of the double patenting rejection, a terminal disclaimer in compliance with 37 CFR 1.321(c) has been submitted to overcome the nonstatutory double patenting rejection of claims 1-3, 6-13, 15-17, 20-27, 29 and 30. I am an attorney of record in the above-identified case and therefore authorized to signed the attached terminal disclaimer.

Docket No. 59474.21800
Application No. 10/763,033
Customer No. 30734

Patent


CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21800.

Respectfully submitted,

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